

## REMARKS

### I. DOUBLE PATENTING REJECTION

Claims 1, 16 and 30 are rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 8, 38 and 57 of co-pending Application No. 09/775,018. This application has now issued as U.S. Patent No. 7,068,684. In response, Applicants hereby file a terminal disclaimer to overcome this obviousness-type double patenting rejection.

### II. REJECTIONS UNDER 35 U.S.C. §112

Claims 11-13 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Examiner has asserted that it is not clearly stated how the first throttling circuit operates in accordance with a mode level and what is referred to as the mode level. In response, Applicants respectfully traverse this rejection. The mode level is described in Figures 5, 6A and 6B, and on page 14, line 4 through page 15, line 22. Figures 6A and 6B describe flow diagrams for how an IP telephone operates when congestion is monitored on the line, and refers to a QOS mode, which is further described with respect to Figure 5. This language and the drawings clearly show how the throttling circuitry within the IP telephone operates in accordance with a mode level.

Claims 30-34 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner has asserted that communication of the information performed in real-time is not described within the Application as is recited within claim 30. Applicants respectfully traverse. Page 12, lines 14-25 of the Specification describes how the invention enables an IP telephone to transmit the audio or multimedia data in real-time. As would be further understood, for a telephone to operate properly, the voice data transmitted by the IP telephone needs to be transmitted to the other end in real-time. Thus, that is the reason for the present invention.

### III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schuster et al.* (U.S. Patent No. 6,650,619) in view of *O'Mahony* (U.S. Patent No. 5,878,120). In response, Applicants respectfully traverse these rejections.

Claim 1 specifically recites a first network device coupled to the modem through the first telephony device, wherein the first telephony device includes first circuitry for throttling data sent from the first network device. The two cited references do not teach or suggest a telephony device coupling a network device to a modem. In *Schuster*, the network device and telephony device are separately connected to the PSTN.

Further, there is no need for throttling data sent from the first network device in *Schuster*. Thus, contrary to the rejection, there is no need to apply teachings of *O'Mahony* into *Schuster*.

Contrary to the rejection's citation of language in columns 13 and 14 of *Schuster*, *Schuster* does not teach throttling data sent from a first network device, wherein such throttling circuitry is included within a telephony device coupled between the first network device and a modem. Instead, *Schuster* merely discloses a reduction in signaling workload at a gateway device. *O'Mahony* may disclose a modem within a DCE, but it does not discuss throttling an amount of data being received, but instead will turn off a transference through the modem of non-voice data in favor of voice data.

As a result, there is no teaching or even a suggestion within the cited art of the specific configuration of the system recited in claim 1 where the first network device is coupled to the modem through the first telephony device, wherein the first telephony device includes throttling circuitry. One skilled in the art at the time the invention was made would not have been able to recreate the invention specifically recited in claim 1 in view of *O'Mahony* and *Schuster*. Instead, the most that the two references might suggest would be to suspend within gateway 12 the transmission to the network 22 of non-voice data from computer 24 in favor of voice data from telephony device 26. Again, however, this configuration is not the same as what is specifically recited within claim 1. Since all of the limitations of the claim are not met by the combination of the prior art references, a *prima facie* case of obviousness has not been proven.

To reiterate, claim 1 recites a modem. *Schuster* does not require a modem. If gateway 12 is replaced with an IP telephone as the Examiner has suggested, a modem is still not needed, since an IP telephone does not need the use of a modem to connect to a network. There is no need for a "missing modem" in *Schuster*, contrary to the assertion by the Examiner on page 11 of

the office action. A modem might only be needed between devices 26 and 44 or between devices 24 and 44 within *Schuster*. However, modems in those locations do not meet the limitations of the claim.

Claim 35 is patentable for reasons similarly given above with respect to claim 1. Claim 35 further recites that the first network device is coupled to the first modem via the first IP telephone so that data communicated between the first network device and the first modem is switched through the first IP telephone. Clearly this configuration is not taught or suggested within either of the cited prior art references. Data from computer 24 is not switched through IP telephone 26 in *Schuster*. Furthermore, gateway 12 is not an IP telephone, and thus the assertions as to how *Schuster* teaches or suggests the configuration of the claim are in error.

The foregoing assertions by Applicants were not in any way addressed by the Examiner in the most recent office action. This is in violation of MPEP §707.07(f).

In fact, the Office Action appears to be asserting that the rejection of claim 1 mostly applies to the rejection of the recitations in claim 35. However, claim 35 is significantly different than claim 1, and the incorporation of the rejection of claim 1 into the rejection of claim 35 does not adequately address the specific recitations of claim 35. For this reason alone, the Examiner has failed to prove a *prima facie* case of obviousness in rejecting claim 35.

Claims 16 and 22 are patentable for reasons similarly given above with respect to claims 1 and 35.

With respect to claims 30, 31 and 34, Applicants note that the Examiner has removed any rejections of these claims in this new office action, except for the double patenting and §112 claim rejections above, which Applicants have addressed.

With respect to claims 20 and 21, nowhere is it disclosed or suggested within the cited prior art that management system 90 in *Schuster* monitors an amount of audio information received by the telephone. System 90 is not disclosed anywhere to occur within a jitter buffer. The limitations have not been met by the rejection. As a result, one skilled in the art at the time the invention was made would not have been able to recreate the invention specifically recited in

claims 20 and 21, since important limitations are not met by the combination of the cited prior art.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

With respect to claims 26 and 32, the Office Action has not explained how the recited language equates to level 2 switching circuitry. There is not even a mention of level 2 switching within either of the cited prior art references. As a result, the Office Action has failed to prove a *prima facie* case of obviousness in rejecting these claims.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

Claims 2, 29 and 38 specifically recite a router coupled between the first telephone device and the modem, or as with respect to claim 38, a router coupling the first IP telephone to the first modem. The rejection glosses over this specific structural relationship by pointing to the router 64 in Fig. 1 of *Schuster* as being coupled to telephone 26. The rejection then asserts that "it would have been obvious to couple the router between the telephone device and the modem in the *Shuster et al.* [sic]." Such an obviousness assertion is without any objective support, which is required under the case law. Nothing in the prior art suggests coupling a router between the telephone device and the modem.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

With respect to claims 7, 19, 23 and 24, Applicants respectfully assert that *Schuster* does not disclose that throttling circuitry is included in the telephony device.

Furthermore, the rejection has ignored significant claim limitations in claim 24. For this reason alone, the Examiner has failed to prove a *prima facie* case of obviousness in rejection claim 24.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

With respect to claim 14, Applicants respectfully assert that there are claim limitations in claim 14 that are not addressed in the rejection of claim 1. For this reason alone, the Examiner has failed to prove a *prima facie* case of obviousness in rejecting claim 14.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

In the rejection of claims 25 and 27, the Examiner has asserted that *Schuster* discloses the network device equates to PC 24 and the telephone device equates to telephone 26. If this is so, then clearly *Schuster* does not disclose or suggest the specific limitations where the data is addressed for transmission from the network device through the telephony device to the wide area network via the modem.

Again, the Examiner has not in any way addressed the foregoing assertions by Applicants, in violation of MPEP §707.07(f).

Claims 8-10 stand rejected under 35 U.S.C. §103 as being unpatentable over *Schuster* in view of *O'Mahony* and further in view of *Beyda et al.* (U.S. Patent No. 6,980,569). In response, Applicants respectfully traverse this rejection. *Beyda* has nothing to do with what is recited within the claims. Thus, the jitter buffer described therein is not applicable to the presently claimed invention, nor does it operate in the same manner. As a result, one skilled in the art would not have combined *Beyda* with *Schuster* and *O'Mahony* to arrive at the claimed invention.

#### IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Applicant : Suder, et al.  
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Respectfully submitted,

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